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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,227	12/27/2000	David S. Luskin	122899-01	5222

28990 7590 08/25/2004

COUDERT BROTHERS
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1114 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
CHIU, RALEIGH W	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/749,227	LUSKIN ET AL.	
	Examiner	Art Unit	
	Raleigh Chiu	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,9 and 15-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,9 and 15-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The status identifiers for claims 7, 8 and 10-14 are incorrect; the claims have been cancelled by applicants in a previous reply.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter as set forth in the previous Office action.

Claim Rejections - 35 USC § 112

4. Claims 1-6 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reasons set forth in the previous Office action. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. Claims 1-6 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention for the reasons set forth in the previous Office action.

Claim Rejections - 35 USC § 103

6. Claims 1-6, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reedhead in view of MacGregor as applied in the previous Office action.

7. Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Reedhead as previously applied in view of U.S. Patent Number 4,399,992 (Molitor).

Regarding claims 16 and 17 and the new "undistorted frame" limitation, it would have been obvious to one of ordinary skill in the art to have the Reedhead racquet include an undistorted frame in view of Molitor who shows the desirability in the racquet frame art to resist distortion resulting from stringing tension. See Molitor at column 3, lines 36-40.

Regarding the added string tension range limitation of about 55-65 pounds, such a range is well-known in the racquet art. Furthermore, the concept of varying racquet tension to change racquet performance is also old and well-known in the art. Because discovering an optimum value of a result effective variable has been held to be within the capabilities of the

person of ordinary skill in the art, it would have been obvious to a person having ordinary skill in this art, by routine experimentation, to provide the Reedhead racquet as modified above with a reasonable tension range, including the 55-65 pounds, in order to obtain optimum racquet performance characteristics.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent Number 287,583 (Claremont).

Regarding claim 18, Figure 1 of Claremont shows a racquet with the recited frame, handle and diagonal strings not positioned within the handle. The intersection angle of the diagonal strings is about 60 degrees. See page 2, lines 55 *et seq*. Although Claremont does not explicitly set forth the recited tension range, such a range is well-known in the racquet art. Furthermore, the concept of varying racquet tension to change racquet performance is also old and well-known in the art. Because discovering an optimum value of a result effective variable has been held to be within the capabilities of the person of ordinary skill in the art, it would have been obvious to a person having ordinary skill in this art, by routine experimentation, to provide Claremont with a reasonable tension range, including the 55-65 pounds, in order to obtain optimum racquet performance characteristics.

Response to Arguments

9. Applicant's arguments filed 03 June 2004 have been fully considered but they are not persuasive.

In their Remarks, applicants have clearly failed to identify anything in the originally filed specification that describes the strings being in a non-distorted shape. Instead, applicants argue that if the racket frame of the present invention is not distorted, then inherently and inevitably, the strings are not distorted (Remarks, page 4) but provide no evidence to establish such inherency. Also, applicants also argue that the examiner has not made any showing which shows that the strings of the disclosed racket are in any way distorted (Remarks, page 5) despite examiner's contention that when strings are tensioned the elongation of the strings can be considered to be distorted (previous Office action, page 3).

In generally, while reviewing claims, the examiner is supposed to take the broadest reasonable interpretation consistent with the specification unless applicants have provided a clear definition in the specification. MPEP § 2111. In the instant application, applicants have provided no specific definition for "distort", especially with respect to strings. As "distort" is defined as "alter the shape (of something) by stress", the fact that the strings are tensioned inherently

means that the strings are distorted. The state of distortion, or lack thereof, of the racket frame is irrelevant. Because the strings are clearly tensioned (and therefore distorted), and claims 1-6 and 15 explicitly call for strings in a non-distorted shape, and there is a clear absence in the originally filed specification of any mention regarding the string's non-distortion, the rejection for failing to comply with the enablement requirement is maintained.

As set forth in the previous Office action, the presence of "strings in a non-distorted shape" renders the claims indefinite. Applicants' unsupported statement that one of ordinary skill would not understand a string tension of about 55-65 pounds to be a string distortion is unconvincing.

Applicants also argue that the MacGregor is not a proper reference because the Office rejection is based on pages 78-79 and that page 78 makes a parenthetical reference to a page 76 which may negate whatever pages 78-79 teach.

It is noted here that page 76 was not included in the previous Office action because it offered no information relevant to the instant claims, not because it included information contradictory to the teachings of pages 78-79. Nevertheless, a copy of page 76 is attached to this Office action which merely states that the complete instructions for

stringing the Bergelin Longstring are listed on pages 78-79. Moreover, it is also noted here that the last three lines of page 79 state that more detailed instructions are available from MacGregor Sporting Goods. The examiner does not have a copy of those instructions and the rejections set forth in this Office action can only assume that the information contained in such instructions does not negate whatever is taught on pages 78-79.

Applicants also argue that because one reference describes a throatless racket while the other racket has a crosspiece, the references are inconsistent and the rejection must be withdrawn. Apparently, applicants are attempting to assert that no two references could ever be used in making an obviousness rejection unless they were identical. The test for obviousness is not whether the features may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Applicants also argue that the racquet of the claimed invention uses at least 25% less string but such a limitation is not in the claims. Since it has been well established that the specification is not the measure of invention, limitations

contained therein cannot be read into the claims for the purpose of avoiding the prior art.

Regarding applicants' arguments with respect to frame flexing and distortion, the slack string set forth in Reedhead and MacGregor clearly would not distort the racquet frame, thereby meeting the limitations of the claims; applicants' reliance on strings tensioned to about 55-65 pounds according to paragraph 14 of the specification is groundless when such a limitation is absent from the claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

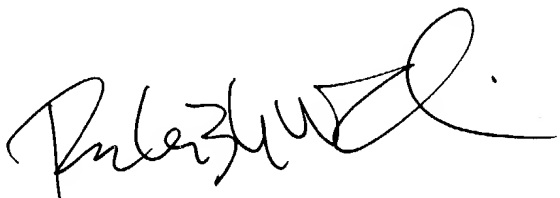
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (703) 308-1513.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif
19 August 2004